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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,453	04/24/2001	Hui-Jung Wu	30-4731 (4780) DIV-1	5324

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EXAMINER

SARKAR, ASOK K

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/841,453

Applicant(s)

WU ET AL.

Examiner

Asok K. Sarkar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-29 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I claims 2 - 28 in Paper No. is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 29 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II claim, there being no allowable generic or linking claim. Election was treated as made **without** traverse in Paper No. 8.
3. Examiner also notes that the Applicant did not elect any species as required by paper No. 7 and asserted that there is no patentable distinction between the two species. The Examiner is considering the assertion as an admission for the two species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Accordingly, the species restriction requirement is withdrawn.

### ***Claim Objections***

4. Claims 2 – 28 are objected to because of the following informalities: The claims are not numbered properly. Claim 20 should be numbered as 2 and the dependent claims should be accordingly renumbered. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin, EP 0849,796 in view of Burns, US 5,750,610.

Regarding claim 20, Jin teaches dielectric porous silica xerogel film produced by hydrolysis/condensation of organosilane compounds (see column 4, lines 23 –28) on a substrate (see Figs. 3 and 7b) whereby the silica film is reacted with a surface modification agent to modify the pore surfaces with HMDS to form a hydrophobic coating on the silica film by reacting silanol groups of the silica film with HMDS in column 4, lines 47 - 52.

Jin fails to expressly teach surface modification agent to comprise one type of oligomer or polymer and reacting under conditions for a sufficient period of time to form the coating.

Burns teaches a method of forming silica xerogels by the hydrolysis/condensation of organosilane compounds and hydrophobizing them by treating with low molecular weight organosiloxanes (in column 1, lines 50 – 57 and also in column 6, line 32) in details in column 5, line 40 and column 6, line 2.

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to modify Jin's hydrophobizing process by replacing the HMDS with an oligomer or polymer as taught by Burns since Jin's silica film is formed

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by the same organosilane compound hydrolysis/ condensation process as the silica gel formed by Burns.

Regarding claim 2, Burns teaches the presence of solvent during reaction in column 6, line 2.

Regarding claims 3 and 4, Jin and Burns teaches the dielectric film of dielectric constant of 1.3 - 3 (see Jin, column 1, line 27) silica gel which inherently contains pores and silanol groups (Jin, column 4, line 43) and Burns teaches the reaction conditions where the reaction is conducted for sufficient amount of time in column 5, line 40 and column 6, line 2.

Regarding claims 5 and 6, Burns teaches temperature range of 20 – 250°C in column 5, lines 62 – 65 and time of about an hour in column 9, lines 3 – 21.

Regarding claim 7, Burns teaches surface modification agent of an oligomer or polymer capable of reacting with the silanols in column 1, lines 50 – 57.

Regarding claims 8, 11, 14, 18 and 19, Burns teaches polymeric organosiloxanes in column 6, line 32, which are formed by reacting a suitable monomer (e.g. chlorosilane or hexamethylsiloxane) with water in a solvent and is also disclosed in the process of column 9, lines 23 – 40 (see also column 6, lines 40 – 52).

Regarding claims 9 and 10, Burns teaches hydrocarbon as solvent in column 6, line 2.

Regarding claims 12 and 13, Burns teaches the presence of water and organic solvent for the reaction in their reaction process but fails to expressly teach the water to organic cosolvent ratio.

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However, it would have been obvious to one with ordinary skill in the art at the time of the invention to judiciously adjust and control these parameters during the hydrophobization process of silica gel film through routine experimentation and optimization to achieve optimum benefits (see MPEP 2144.05).

Regarding claim 15 and 16, Jin teaches surface treatment with a monomeric surface modifying agent and Burns teaches, in addition, surface treatment with a polymeric surface modifying agent that reacts with the silanol groups of the silica gel and it would have been obvious to one with ordinary skill in the art at the time of the invention to apply Jin's process and then modify the process by applying Burns' process.

Regarding claim 17, Burns teaches surface modifying agents of monomer as well as polymer of high molecular weight which cleaves to low molecular weight in column 6, lines 30 – 35 and mixtures of two or more are taught by Burns in column 6, lines 36 – 39.

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to modify Jin's method by using a combination of a monomer and a polymer as taught by Burns so that the hydrophobization process is improved.

Regarding claim 21, Jin teaches strong silica dielectric of porous structure (dielectric constant of 1.3 – 3 in column 1, line 27) suitable for drying and polishing in columns 4 and 5, but fails to expressly teach the break strength of 2000 PSI.

However, it would have been obvious to one with ordinary skill in the art at the time of the invention to modify Jin's process by applying Burns' process and produce a

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silica gel structure of break strength above 2000 PSI by controlling the porosity of the gel by proper drying process since strength of a material is controlled by the amount and the size of the pores.

7. Claims 22 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin, EP 0849,796 in view of Burns, US 5,750,610.

These claims are rejected by applying the same prior art and arguments as were provided above in rejecting claims 2 – 21 since they are not patentably distinct from claims 2 – 21 and is also taught by Jin in column 1, line 6.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 2 – 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 19 of U.S. Patent No.

6,318,124 in view of Burns, US 5,750, 610. US 6,318,124 teaches dielectric nanoporous silica film on a substrate by forming a coating with an oligomer or polymer of organo

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siloxanes, but fails to teach that the coating is capable of reacting with the silanol groups as a surface modification agent and render it hydrophobic.

Burns teaches that such organosiloxanes are capable of reacting with the silanol groups of a porous silica gel and hydrophobize the surface as described earlier in rejecting claims 2 – 28.

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to use Rutherford's process and at the same time automatically hydrophobize the silica surface since the silanol group on the silica film will react with the polysiloxanes to render hydrophobic character to the dielectric film as taught by Burns.

#### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asok K. Sarkar whose telephone number is 703 238 2521. The examiner can normally be reached on Monday - Friday (8 AM- 5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Sherry can be reached on 703 308 1680. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7722 for regular communications and 703 308 7722 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 4918.

Asok K. Sarkar  
June 12, 2002

A handwritten signature in black ink, appearing to read "Michael Sherry", with the date "6/17/02" written below it.

**MICHAEL SHERRY**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**